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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/775,039 | 02/09/2004 | Kevin P. Parker | PRKR-4600 | 6907 |
| Philip A. Girard GIRARD & EQUITZ LLP Suite 1110 400 Montgomery Street San Francisco, CA 94104 | | | EXAMINER TRAN, KHOI H | |
| | | | ART UNIT 3651 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | | MAIL DATE | DELIVERY MODE |
| 3 MONTHS | | | 01/17/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/775,039

Applicant(s)

PARKER ET AL.

Examiner

Khoi H. Tran

Art Unit

3651

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26, 28, 30-44 and 46-58 is/are allowed.
- 6) ☒ Claim(s) 27, 29, 45 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant is advised that the Notice of Allowance mailed 09/27/2006 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

2. Prosecution on the merits of this application is reopened on claims 27, 29, 45, and 59 are considered unpatentable for the reasons indicated below.

Claim Objections

3. Claims 27, 29, 45, and 59 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

The test as to whether a claim is a proper dependent claim is: it shall include every limitation of a claim from which it depends (35 U.S.C. 112, fourth paragraph). In other words, it shall not conceivably be infringed by anything that would not also infringe the basic claim (The Infringement Test, see M.P.E.P 608.01(n) III). In this instant case, it is conceivable to infringe dependent product claim without infringing the independent process claim, i.e. see 35 U.S.C 102/103 rejections below. Therefore, claims 27, 29, 45, and 59 fail the infringement test and are improper dependent claims.

In response to Applicant's arguments and the cited case law Scripps Clinic & Research Foundation v Genentech Inc., 927 F.2d 1565, (Fed Cir 1991), the product of claim 13 therein can only be made by the independent process claim 1. Therefore, the dependent product claim 13 is a proper dependent claim. It passed the infringement test. In other words, one could not infringe the dependent product claim 13 without infringing the independent process claim 1.

Applicant's claims 27, 29, 45, and 59, on the other hand, could be made by different process steps including Fogg 2,646,726 and Ackley 1,642,866 processes (see rejections below). Hence, the product claims could be infringed while the process claims are not. Applicant's dependent product claims do not pass the infringement test and therefore, are improper independent claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 27, 29, 45, and 59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for a sheet being conditioned per the claimed process. The specification only provided enablement for conditioning the edge

Art Unit: 3651

of a stack of sheets. The process of conditioning a single sheet as claimed was not supported in the specification. It is true that a stack of sheets would contain plurality of single sheets. However, the current language of the claims presents a non-enablement problem because one of ordinary skill in the art would not be able to condition just a single sheet per Applicant's claimed process. It is recommended that -- a stack of sheets having plurality of single sheets -- be used instead of just "a sheet."

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27, 29, 45, and 59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fogg 2,646,726.

Fogg '726 discloses a sheet per claimed invention. See MPEP 2213.

8. Claims 27, 29, 45, and 59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ackley 1,642,866.

Ackley '866 discloses a sheet per claimed invention. See MPEP 2113.

Allowable Subject Matter

9. Claims 1-26, 28,30-44, and 46-58 are allowable over the prior art of record.

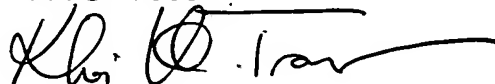
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khoi H Tran
Primary Examiner
Art Unit 3651



KHT
11/30/2006